

REMARKS

This application has been reviewed in light of the Office Action dated August 11, 2004. Claims 32-50 are presented for examination, of which Claims 32, 39, 44, 45, and 50 are in independent form. Claims 1-31 have been canceled, without prejudice or disclaimer of subject matter, and will not be discussed further. Claims 32-50 have been added to provide Applicant with a more complete scope of protection. Favorable reconsideration is requested.

The Office Action objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5), because they include reference characters allegedly not mentioned in the specification.

As to reference character 16 in Figure 1, Applicant respectfully directs the Examiner's attention to page 8, line 31, of the specification as originally filed, which clearly refers to reference character 16. As to reference character 26 in Figure 1, Applicant has amended the specification at page 9, line 14, to recite --a certain number of computers 20, 21, and 22, connected to together by a network 26--.

As to the objection to Figure 4, Applicant has amended the specification at page 16, line 22, to change "S7" to read --S6--.

It is believed that the objections to Figures 1 and 4 have been obviated, and their withdrawal is therefore respectfully requested.

Claims 8, 15, 16, 29, and 30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-5, 7-10, 12-16, and 18-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,923,013 (*Suzuki et al.*) in view of U.S. Patent

No. 6,219,155 (*Zuber*), and Claim 6 was rejected under Section 103(a) as being unpatentable over *Suzuki et al.* and *Zuber*, in view of U.S. Patent No. 5,715,379 (*Pavlovic et al.*).

Cancellation of Claims 1-31 renders their rejections moot, but Applicant submits the following comments regarding the patentability of new Claims 32-50 over the cited references.

The aspect of the present invention set forth in Claim 32 is a method of controlling the processing of a computer document by a computer peripheral. The computer document comprises a plurality of sub-parts to which is associated a predetermined order of processing. The method includes acquiring context data indicative of at least one of a type of information contained in a sub-part of the plurality of sub-parts and an operating characteristic of the computer peripheral, and modifying the predetermined order of processing by the computer peripheral of the sub-parts of the computer document according to the acquired context data.

Among other important features of Claim 32 is modifying the predetermined order of processing by the computer peripheral of the sub-parts of the computer document according to the acquired context data.

U.S. Patent No. 5,923,013 (*Suzuki et al.*) relates to a print control system. The *Suzuki et al.* system manages a print job on a job basis and a page basis. In the *Suzuki et al.* system, a user controls the printing process. Column 2, lines 5-8, and column 26, lines 42-51, state that a user is provided many functions, including print job concurrent binding, print job hierarchical binding, page addition, page replacement, and page deletion. Further, as discussed in the JDF edit routine, column 12, line 28, to column 16, line 11,

processing of the document, such as “print sequence change mode”, is performed based on a user selection. In contrast, the present invention, as defined by Claim 32, modifies the predetermined order of processing by the computer peripheral of the sub-parts of the computer document according to the acquired context data.

Accordingly, nothing has been found in *Suzuki et al.* that would teach or suggest modifying the predetermined order of processing by the computer peripheral of the sub-parts of the computer document according to the acquired context data, as recited in Claim 32.

For at least this reason, Applicant submits that Claim 32 is clearly patentable over *Suzuki et al.*, taken alone.

Zuber is not seen to remedy the deficiencies of *Suzuki et al.*, with respect to modifying the predetermined order of processing by the computer peripheral of the sub-parts of the computer document according to the acquired context data.

Zuber relates to a plurality of print engines arranged in parallel to process print jobs in a parallel manner. In the *Zuber* system, a job manager routes black and white pages to a first print engine, and routes color pages to a second print engine. Figure 12, and the associated description in the specification, depicts a parsing operation of the *Zuber* system. As discussed at column 15, line 50, to column 16, line 26, the job manager of the *Zuber* system performs the parsing operation, allowing pages to be distributed in a parallel manner. However, Applicant has found nothing in *Zuber* that discusses modifying the order of printing the pages of a print job.

Accordingly, nothing has been found in *Zuber* that would teach or suggest modifying the predetermined order of processing by the computer peripheral of the sub-

parts of the computer document according to the acquired context data, as recited in Claim 32.

Therefore, even if *Suzuki et al.* and *Zuber* were to be combined, assuming such a combination would even be permissible, the result would not meet the terms of Claim 32.

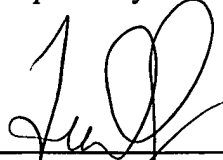
Independent Claims 44 and 50 are device and computer-readable storage medium claims respectively corresponding to method Claim 32, and are believed to be patentable over *Suzuki et al.* and *Zuber* for at least the same reasons as discussed above in connection with Claim 32. Additionally, independent Claims 39 and 45 include features similar to those discussed above in connection with Claim 32. Accordingly, Claims 39 and 45 are believed to be patentable for reasons substantially similar as those discussed above in connection with Claim 32.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



Frank A. DeLucia
Attorney for Applicant
Registration No.: 42,476

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 463408v1